

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte FRANKLIN C. BRADSHAW
and

THOMAS L. SODERMAN



Appeal No. 2005-0829
Application No. 09/664,794¹

HEARD: June 7, 2005

Before PATE, NASE, and DELMENDO, Administrative Patent Judges.
NASe, Administrative Patent Judge.

REMAND

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly,

¹ Application filed September 19, 2000, for reissue of U.S. Patent No. 5,584,962 (Application No. 08/247,003, filed May 20, 1994), issued December 17, 1996. This application is a continuation of Application No. 09/213,876 filed December 17, 1998 (now U.S. Patent No. RE 37,345, issued September 4, 2001)).

37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

THE REJECTION UNDER APPEAL

Claims 36 to 48 stand rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. The basis advanced by the examiner for this rejection is as follows (answer (mailed August 12, 2004), pp. 3-4):

A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

In US Patent Application 08/247,003 (US Patent 5,584,962), applicant surrendered subject matter during prosecution of the application in order to overcome a rejection. This surrendered subject matter includes:

a pretensioning means including a tensioning cap affixed to the cores the caps having an end plate engaging the end of the associated core and the plate with securement means engagable in the mounting means and further including biasing means for applying a predetermined force biasing the end plate into engagement with the end of the roll core.

Newly added claim 36 does not include the limitations which applicant presented in application 08/247,003 to overcome the prior art of record. Thus applicant is attempting to recapture subject matter that was surrendered in application 08/247,003. See MPEP 1412.02 – examples A-C.

THE APPELLANTS' ARGUMENT

The appellants' arguments against this rejection are set forth in the brief (filed February 14, 2003) and the reply brief (filed July 24, 2003). The appellants assert that the examiner incorrectly applied a "per se" analysis with respect to the "pre-tensioning means" limitations that were added to the claims during the original prosecution of the '962 patent, but omitted from the reissue claims currently on appeal in the present application. The appellants argue that the examiner's application of a "per se" bar against reissue claims that are broader in respect to limitations added to secure allowance of an issued claim, irrespective of the presence of other materially narrowing limitations (e.g., the limitations discussed in the brief with respect to the "outer shell"), is inconsistent with the flexible approach adopted by the courts under the recapture rule. Specifically, in Ball Corp. v. United States, 729 F.2d 1429, 221 USPQ 289 (Fed. Cir. 1984), the Federal Circuit expressly adopted a "liberal approach" to the recapture rule, and stated that the recapture rule is "based on equitable principles." 729 F.2d at 1436 and 1438, 221 USPQ at 294 and 296. The appellants state that specific purpose of allowing a patent to be corrected through the reissue procedure is to allow the patentee to correct errors such as "claiming more or less than he had a right to claim." 35 U.S.C. § 251 (underlining added by the appellants). By adding the "pre-tensioning means" limitations to the issued claims, the appellants assert that they claimed less than they had a right to claim, and are attempting to correct this error by securing a different claim

scope that does not recapture the same claim scope that was "surrendered" during prosecution.

PROSECUTION HISTORY OF PATENT

Application No. 08/247,003 was filed on May 20, 1994 with 20 claims.

Independent claims 1, 11 and 20 read as follows:

1. An applicator and transfer device comprising:
 - (a) a frame having opposite sides;
 - (b) a first nip roller rotatably mounted and extending between said sides;
 - (c) a first mounting means for mounting a feed roll to said frame;
 - (d) a second nip roller rotatably mounted and extending between said sides;
 - (e) a second mounting means for mounting a feed roll to said frame; and
 - (f) actuating means for imparting rotation to at least one of said nip rollers.
11. An applicator and adhesive transfer device comprising:
 - (a) an upper frame member having opposite sides and a lower frame member having opposite sides, said upper frame member being pivotally connected to said lower frame member;
 - (b) a first nip roller rotatably mounted and extending between the sides of said upper frame member;
 - (c) a first mounting means associated with the upper frame member;
 - (d) a second nip roller rotatably mounted and extending between the sides of said lower frame member;
 - (e) a second mounting means associated with the said lower frame member; and
 - (f) actuating means for imparting rotation to at least one of said nip rollers.
20. A feed roll comprising a generally cylindrical core having an end plate engaging at least one end thereof with projection means thereon for mounting said roll and further including means for applying a predetermined force biasing said end plate into engagement with the end of said core to maintain a predetermined pay-out feed tension.

In the first Office action (mailed March 2, 1995), claims 1 to 20 were rejected under 35 U.S.C. § 103.

On July 5, 1995, in response to that rejection, the appellants amended claims 1 and 11² as follows:

1. An applicator and transfer device comprising:
 - (a) a frame having opposite sides;
 - (b) a first nip roller rotatably mounted and extending between said sides;
 - (c) a first mounting means for mounting a feed roll to said frame;
 - (d) a second nip roller rotatively mounted and extending between said sides adjacent said first nip roller;
 - (e) a second mounting means for mounting a feed roll to said frame; and
 - (f) actuating means for imparting rotation to at least one of said nip rollers;
 - (g) first and second rolls of material having a core about which material is wound and each having support means for supporting said rolls for rotation in said respective first and second mounting means; and
 - (h) pre-tensioning means associated with said support means and said cores for selectively establishing a predetermined resistance to rotation of the said rolls of material to maintain the proper application tension for the material.
11. An applicator and adhesive transfer device comprising:
 - (a) an upper frame member having opposite sides and a lower frame member having opposite sides, said upper frame member being pivotally connected to said lower frame member;
 - (b) a first nip roller rotatively mounted and extending between the sides of said upper frame member;
 - (c) a first mounting means associated with the upper frame member;
 - (d) a second nip roller rotatively mounted and extending between the sides of said lower frame member;
 - (e) a second mounting means associated with the said lower frame member; and

² Claim 20 was not amended.

(f) first and second rolls of feed stock material each having a core about which the feed stock material is wound and having support means for supporting said rolls for rotation in said respective first and second mounting means;

(g) pre-tensioning means integrally associated with said core and mounting means for selectively establishing a predetermined resistance to rotation of the rolls of feed stock material to maintain the proper application tension for the feed stock material; and

(h) actuating means for imparting rotation to at least one of said nip rollers.

In the final rejection (mailed October 25, 1995), claims 1 to 20 were rejected under 35 U.S.C. § 103.

In response to the final rejection, the appellants amended claims 1 and 11³ as follows:

1. An applicator and transfer device comprising:
 - (a) a frame having opposite sides;
 - (b) a first nip roller rotatably mounted and extending between said sides of said frame;
 - (c) a first mounting means for mounting a feed roll to said frame;
 - (d) a second nip roller rotatively mounted and extending between said sides of said frame adjacent said first nip roller;
 - (e) a second mounting means for mounting a feed roll to said frame;
 - (f) actuating means for imparting rotation to at least one of said nip rollers;
 - (g) first and second feed rolls of material each having a generally cylindrical core about which feed material is wound and each having support means for supporting said rolls being supported for rotation in said respective first and second mounting means; and
 - (h) pre-tensioning means associated with each of said support means and said core cores for selectively establishing a predetermined resistance to rotation of the rolls of material to provide the proper application tension for unwinding the

³ Claim 20 was canceled.

feed material wherein said pre-tensioning means includes a tensioning cap affixed to said cores, said caps having an end plate engaging the end of the associated core and said plate with securement means engageable in said mounting means and further including biasing means for applying a predetermined force biasing said end plate into engagement with the end of said roll core.

11. An applicator and adhesive transfer device comprising:

- (a) an upper frame member having opposite sides and a lower frame member having opposite sides, said upper frame member being pivotally connected to said lower frame member;
- (b) a first nip roller rotatively mounted and extending between the sides of said upper frame member;
- (c) first mounting means associated with the upper frame member;
- (d) a second nip roller rotatively mounted and extending between the sides of said lower frame member;
- (e) second mounting means associated with the said lower frame member;
- (f) first and second rolls of feed stock material each having a generally cylindrical core about which the feed stock material is wound and having support means for supporting said rolls being supported for rotation in said respective first and second mounting means;
- (g) pre-tensioning means integrally associated with each of said cores and mounting means for selectively establishing a predetermined resistance to rotation of the rolls of feed stock material to provide the proper application tension for the feed stock material, said pre-tensioning means including a tensioning cap affixed to said associated core having an end plate engaging the associated core and said plate having with securement means engageable in said mounting means and further including biasing means for applying a predetermined force biasing said end plate into engagement with the associated core; and
- (h) actuating means for imparting rotation to at least one of said nip rollers.

Claims 1 and 11 were allowed by the examiner on April 16, 1996 and issued

December 17, 1996 as claims 1 and 10 of U.S. Patent No. 5,584,962.

THE REJECTED CLAIMS

A copy of the dependent claims under appeal is set forth in the appendix to the appellants' brief. Claims 36 and 47, the independent claims on appeal, read as follows:

36. An apparatus for processing a master in conjunction with a supply of a first feed material and a supply of a second feed material, at least one of said feed materials carrying a layer of adhesive, said apparatus comprising:

a frame having an outer shell including (a) a lower outer shell portion having downwardly facing surfaces constructed and arranged to be placed on a substantially flat support surface for supporting said apparatus and (b) an upper outer shell portion movably connected to said lower shell portion for movement between an open position and a closed position relative to said lower outer shell portion by manually engaging said upper outer shell portion directly and lifting said upper outer shell portion upwardly to said open position thereof; and

a pair of cooperating pressure applying structures located within said outer shell, said cooperating structures being constructed and arranged to be positioned adjacent one another in a cooperating pressure applying relationship wherein, when the master with the first and second feed materials on opposing sides thereof and the adhesive contacting the master is positioned between said cooperating structures, said cooperating structures apply pressure to said master and feed materials as they advance therethrough so as to bond said adhesive to said master;

an upper one of said pair of said cooperating pressure applying structures being connected with said upper outer shell portion such that (a) movement of said upper outer shell portion to said open position thereof moves the upper one of said cooperating pressure applying structures apart from a lower one of said cooperating pressure applying structures to facilitate positioning of said feed materials in between said cooperating structures and (b) movement of said upper outer shell portion to said closed position thereof positions the upper one of said cooperating structures adjacent the lower one of said cooperating pressure applying structures in said cooperating pressure applying relationship as aforesaid;

said frame providing a first mounting portion constructed to receive and mount said supply of said first feed material and a second mounting portion constructed and arranged to receive and mount said supply of said second feed material.

47. A method for using an apparatus for processing a master in conjunction with a supply of a first feed material and a supply of a second feed material, at least one of said feed materials carrying a layer of adhesive, said apparatus comprising: a frame having an outer shell including (a) a lower outer shell portion having downwardly facing surfaces constructed and arranged to be placed on a substantially flat support surface for supporting said apparatus and (b) an upper outer shell portion movably connected to said lower shell portion for movement between an open position and a closed position relative to said lower outer shell; and a pair of cooperating pressure applying structures located within said outer shell, said cooperating structures being constructed and arranged to be positioned adjacent one another in a cooperating pressure applying relationship wherein, when the master with the first and second feed materials on opposing sides thereof and the adhesive contacting the master is positioned between said cooperating structures, said cooperating structures apply pressure to said master and feed materials as they advance therethrough so as to bond said adhesive to said master; an upper one of said pair of said cooperating pressure applying structures being connected with said upper outer shell portion such that (a) movement of said upper outer shell portion to said open position thereof moves the upper one of said cooperating pressure applying structures apart from a lower one of said cooperating pressure applying structures to facilitate positioning of said feed materials in between said cooperating structures and (b) movement of said upper outer shell portion to said closed position thereof positions the upper one of said cooperating structures adjacent the lower one of said cooperating pressure applying structures in said cooperating pressure applying relationship as aforesaid, said method comprising:

manually engaging said upper outer shell portion directly and lifting said upper outer shell portion upwardly to said open position thereof,

disposing said first and second feed materials in such a position with respect to said cooperating pressure applying structures that, when said upper outer shell portion is lowered to said closed position thereof to move said upper one of cooperating structures adjacent the lower one of said cooperating pressure applying structures said cooperating pressure applying relationship thereof, said first and second feed materials will be positioned between said cooperating structures;

then lowering said upper outer shell portion to said closed position thereof to position the upper one of said cooperating structures adjacent the lower one of said cooperating pressure applying structures in said cooperating pressure applying relationship thereof with said first and second feed materials positioned therebetween; and

while said upper outer shell portion is in said closed position thereof and said cooperating structures are in said cooperating pressure applying relationship thereof with said first and second feed materials therebetween, advancing said master with the first and second feed materials on opposing sides thereof and said adhesive contacting the master between said cooperating structures such that said cooperating structures in said cooperating pressure applying relationship thereof apply pressure to said master and feed materials as they advance therethrough so as to bond said adhesive to said master.

RECAPTURE UNDER 35 U.S.C. § 251

A precedential opinion concerning a reissue recapture rejection under 35 U.S.C. § 251 was entered May 29, 2003 in Ex parte Eggert, 67 USPQ2d 1716 (Bd. Pat. App. & Int. 2003). In Eggert, the majority opinion applied the fact-specific analysis set forth in In re Clement, 131 F.3d 1464, 1468-71 45 USPQ2d 1161, 1164-66 (Fed. Cir. 1997), determined that under the facts and circumstances before it, the "surrendered subject matter" was claim 1 of Eggert as that claim existed prior to the post-final rejection amendment that led to the allowance of claim 1 in the original patent, and decided that reissue claims 15-22 of Eggert were not precluded (i.e., barred) by the "recapture rule." 67 USPQ2d at 1730-33.

The Federal Circuit in Clement set forth a three step process for determining if the recapture doctrine should be applied against claims in a reissue application.

The first step in applying the recapture doctrine is to determine whether and in what "aspect" the reissue claims are broader than the patent claims. For example, a reissue claim that deletes a limitation or element from the patent claims is broader in that limitation's aspect.

The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. To determine whether the appellants have surrendered particular subject matter, one must look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection.

The third step is that once it is determined that the appellants have surrendered the subject matter of the canceled or amended claim, it must then be determined whether the surrendered subject matter has crept into the rejected reissue claims. Comparing the reissue claim with the canceled claim is one way to do this.⁴ If the scope of the reissue claim is as broad as or broader than the canceled or amended claim in all aspects, then the recapture doctrine bars the claim. In contrast, a reissue claim narrower in scope than the canceled or amended claim in all aspects escapes the

⁴ In re Wadlinger, 496 F.2d 1200, 1204, 181 USPQ 826, 830 (CCPA 1974).

recapture doctrine entirely. However, if the reissue claim is broader than the canceled or amended claim in some aspects, but narrower than the canceled or amended claim in others, then the broadening aspects of the reissue claim must be balanced against the narrowing aspects of the reissue claim.⁵

ACTION

In the recapture rejection before us in this appeal, the examiner has not compared the subject matter of claims 36 to 48 to the "surrendered subject matter." Instead, the examiner has compared claims 36 to 48 to the allowed claims that issued as the patent.⁶ As such, the examiner has not set forth a prima facie case to support a recapture rejection.

⁵ If the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture doctrine bars the claim. See Mentor Corp. v. Coloplast Inc., 998 F.2d 992, 996, 27 USPQ2d 1521, 1525 (Fed. Cir. 1993). If the reissue claim is narrower in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the recapture doctrine does not bar the claim. See Ball Corp. v. United States, 729 F.2d 1429, 1435, 221 USPQ 289, 294 (Fed. Cir. 1984); Ex parte Eggert, 67 USPQ2d 1716, 1731-32, (Bd. Pat. App. & Int. 2003). In Clement, the court found that the reissue claim was both narrower than the canceled claim in an aspect germane to prior art rejection and broader than the canceled claim in an aspect germane to prior art rejection. The Clement court concluded that, "[o]n balance, reissue claim 49 is broader than it is narrower in a manner directly pertinent to the subject matter that Clement surrendered throughout the prosecution" and thus was impermissible under the recapture rule. 131 F.3d at 1471, 45 USPQ2d at 1166. In Pannu v. Storz Instruments Inc., 258 F.3d 1366, 1370-71, 59 USPQ2d 1597, 1600 (Fed. Cir. 2001), the court also found that the narrowing aspects of the reissue claim were not enough to outweigh the broadening aspects of the reissue claim.

⁶ In that regard, the text of the "pretensioning means" quoted by the examiner as being part of the surrendered subject matter (see page 2 of this decision) is incorrect since that language was added by the appellants to claim 11 to secure allowance. That is, claim 11 with the "pretensioning means" quoted by the examiner was never subject to any rejection and thus never became surrendered subject matter.

We remand this application to the examiner to determine whether a recapture rejection under 35 U.S.C. § 251 is appropriate. In making this determination, the examiner must follow the three-step process established by In re Clement, 131 F.3d at 1468-71 45 USPQ2d at 164-66. The first step is to determine whether and in what aspect the reissue claims are broader than the patent claims. The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. Finally, the third step is to determine whether the reissue claims have been materially narrowed in other respects to avoid the recapture rule.

While the examiner performed the first step, the examiner has not performed the second and third steps. To perform the second step the examiner must determine what subject matter constitutes "surrendered subject matter." "Surrendered subject matter" is subject matter that applicant has admitted was not patentable over the prior art such as by deliberately canceling or amending a claim to overcome prior art.⁷ If the reissue claim is as broad as or broader than the canceled or amended claim [the surrendered subject matter] in all aspects, the recapture rule bars the claim. If it is narrower than the canceled or amended claim [the surrendered subject matter] in all aspects, the

⁷ Clearly, claims 1 and 11 as presented in the amendment filed July 5, 1995 constitutes surrendered subject matter since these claims were subject to a prior art rejection and then amended to overcome the prior art rejection.

recapture rule does not apply. If the reissue claim is broader than the canceled or amended claim [the surrendered subject matter] in some aspects, but narrower than the canceled or amended claim [the surrendered subject matter] in other aspects, then the examiner must determine if each broadening aspect or narrowing aspect is or is not germane to a prior art rejection, then the examiner must balance the narrowing aspects against the broadening aspects to determine if the recapture rule bars each claim. Id.

CONCLUSION

The application has been remanded to the examiner for further consideration as set forth above.

This application, by virtue of its "special" status, requires immediate action, see
MPEP § 708.01.

REMANDED



WILLIAM F. PATE, III
Administrative Patent Judge



JEFFREY V. NASE
Administrative Patent Judge

)
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ROMULO H. DELMENDO
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